

Office Action Summary	Application No.	Applicant(s)	
	09/595,677	LAOR, RAVIV	
	Examiner	Art Unit	
	John Van Bramer	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 22 March 2006.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-3, 11 and 28-31 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-3, 11 and 28-31 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 30 March 2006 is/are: a) accepted or b) objected to by the Examiner.

 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) Notice of Informal Patent Application (PTO-152)
6) Other: _____.

DETAILED ACTION

Response to Amendment

1. The amendment filed on March 22, 2006, made amendments to the drawings and the specification. Additionally, Claim 1 was amended, Claims 4-10 and 12 – 27 were cancelled, and new Claims 28 – 31 were added. Thus the currently pending claims addressed in the office action below are Claims 1-3, 11, and 28 – 31.

Specification

2. The amendment filed March 22, 2006 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

The examiner is unclear as to whether the applicant's representative has admitted that new matter has been added. Page 16, Section III. REMARKS, line 8 of the amendment filed on March 22, 2006 contains the sentence "Now new matter has been added". While this may be a typographical error, the examiner asserts that the original specification incorporated by reference only the portion of U.S. Patent No. 6,041,309 related to the commercial server system using the promotion server system to process the redemption of the promotion and did not incorporate by reference U.S. Patent No. 6,041,309 in its entirety (Specification submitted 6/19/2000, Page 6, lines 7-13). The applicant added a significant amount of matter to the

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specification (11 pages were added to a 14 page specification), much of which is considered new matter since it is not specific to the promotion server system processing the redemption. For example:

- a. All new embodiments incorporating the use of "cookies", such as Page 19, lines 9-22 of the Specification submitted on 3/22/2006, are considered new matter.
- b. Drawings 103; 104 and 105 have incorporated a clearing house which is not mentioned in the original specification

Applicant is required to cancel all new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-3, 11, 28-31 are rejected under 35 U.S.C. 102(b) as being anticipated by Gerace (5,848,396).

Claim 1: Gerace discloses a system and method for managing promotions over a network, comprising:

- a. A promotion server system including a computer processor and associated datastore, said datastore containing data representative of terms and statistics of

one or more item promotions and electronic tokens. (Col 3, lines 39-67 and Col 4, lines 30 - 47)

- b. A commercial server system including a computer processor and associated commercial datastore, said commercial datastore containing data representative of terms and statistics of one or more item promotions and electronic tokens, said commercial server system being selectively coupleable to said promotions server system over said network. (Col 3, lines 39-67 and Col 4, lines 11 – 36)
- c. A client server system including a computer processor and associated client datastore, said client datastore containing data representative of terms and statistics of one or more item promotions and electronic tokens, said client server system being selectively coupleable over said network to said promotion server system and to said commercial server system. (Col 3, lines 39-67, Col 4, lines 1 - 10) (Since the promotion is displayed on a clients computer, the clients computer inherently has a datastore containing data representative of the terms and statistics of the displayed coupon in a datastore (temp file or virtual memory))
- d. Wherein said commercial server system further includes a script for generating a website frame having a predetermined signature. (Col 4, line 56 through Col 5, line 25)
- e. Wherein said commercial server system distributes said website frame over said network to said promotion server system. (Col 3, lines 39-67; Col 5, lines 15 – 25)

- f. Wherein said client server system connects to said promotion server system over said network. (Col 3, lines 39-67)
- g. Wherein said promotion server system transmits said electronic token from said website frame over said network to said client server system. (Col 4, lines 50 – 55)
- h. Wherein said promotion server system transmits over said network to said commercial server system coupon information associated with the client received from said electronic token. (Col 5, lines 8 – 40)

Claim 2: Gerace discloses a system for managing promotions over a network as in Claim 1 above, and further discloses the commercial server system accepting or declining the promotions (Col 17, line 53 – Col 20, line 30, especially Col 19, lines 33-41).

Claim 3: Gerace discloses a system for managing promotions over a network as in Claim 1 above, and further discloses the promotion server system providing statistics pertaining to the number and value of redeemed promotions to the commercial server system (Col 11, line 57 – Col 13, line 33).

Claim 11: Gerace discloses the system of Claims 1, and further discloses using a screen display to display the promotion data when requested (opted) by the

commercial server system (Col 11, line 57 – Col 13, line 33 and Col 17, line 53 – Col 20, line 30).

Claims 28 and 30: Gerace discloses a system and computer network implemented method for managing promotions over a network comprising:

- a. A promotion server. (Col 3, lines 39-67 and Col 4, lines 30 - 47)
- b. A retailer's commercial server. (Col 3, lines 39-67 and Col 4, lines 11 – 36)
- c. A consumer's client computer. (Col 3, lines 39-67, Col 4, lines 1 - 10)
- d. Wherein said advertiser's promotion server; said retailer's commercial server; and said consumer's client computer are operably connected to the Internet, and are structured and programmed so that said consumer's client computer can request from said retailer's commercial server a promotion; and said retailer's commercial server responds to request from said consumer's client computer for said promotion by automatically obtaining from said promotion server promotion authorization data for said promotion, and said retailer's commercial server determines from said authorization data whether to accept or decline said promotion. (Col 3, lines 39-67; Col 5, lines 8 – 40; and Col 11, line 57 through Col 12, line 56) (The Gerace invention checks to see if a viewing opportunity is adequate. If the viewing opportunity meets the advertisers display requirement, the commercial server accepts (inserts) or declines the advertisement to the consumer.)

Claims 29 and 31: Gerace discloses the system of claims 28 and 30 respectively, wherein said retailer's commercial server selecting a promotion accounting report option, wherein said promotion server transfer transfers screen display data to said retailer's commercial server system that provides said retailer's commercial server system with statistics that include the dollar value of promotions redeemed by said consumer's client computer. (Col 5, lines 26 – 40)

Response to Arguments

5. Applicant's arguments filed March 22, 2006 have been fully considered but they are not persuasive.
 - a. The applicant argues that Gerace does not disclose the three party system including consumer's computer that requests redemptions from a retailer's computer system wherein the retailer computer system looks to a back end computer system for information whether to provide redemption. However, Gerace discloses that his invention consists of various parts such as an agate data assembly, a user profiling member, an advertisement module and a program controller (Col 4, lines 37 – 37). Gerace also discloses that these various parts can reside on a multiplicity of servers or on a server cluster (Col 3, lines 39 – 67). Therefore, the location of each part of the invention disclosed may reside on one server or many and still perform in the manner disclosed by Gerace.

b. Regarding applicants argument about looking for information regarding whether or not to provide promotion redemption, the examiner finds no currently pending claims in the immediate amendment that are directed towards obtaining information regarding whether to provide a redemption.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Van Bramer whose telephone number is (571) 272-8198. The examiner can normally be reached on 9am - 5pm Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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